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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/760,363 | 01/21/2004 | Hiroshi Miyahara | 040012 | 9816 |
| 23850 | 7590 | 06/02/2006 | EXAMINER | |
| ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP | | | LUU, MATTHEW | |
| 1725 K STREET, NW | | | ART UNIT | PAPER NUMBER |
| SUITE 1000 | | | | 3663 |
| WASHINGTON, DC 20006 | | | | |

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/760,363 | MIYAHARA, HIROSHI | |
| | Examiner | Art Unit | |
| | LUU MATTHEW | 3663 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 March 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 7-10 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 11 and 16-41 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 7-10 and 12-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 January 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/04 & 4/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

Claims 1-6, 11 and 16-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Inventions and Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 27, 2006.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7-10 and 12-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/736,547 ('574). Although the conflicting claims are not identical, they

are not patentably distinct from each other because claims 7-10 and 12-15 of this present application is broader than claims 1-9 of copending Application No. 10/736,547.

For example, claim 1 of the copending application ('574) teaches "wherein the map information includes matching data that has a plurality of matching mesh information divided into a predetermined area, the matching mesh information containing a plurality of point information each of which has coordinates information and unique point information and represents a predetermining point, and segment information which has unique segment information and connects a pair of the point information representing a road".

Claim 1 of the copending application ('574) does not teach "a feature guidance information acquiring section", "a current position information acquiring section", and "a guidance providing section" as recited in claim 7 of the present invention.

However, claim 1 the copending application ('574) also recites "a terminal unit" and "a server unit". Therefore, it is well known in the art that the terminal unit would have a transceiver that functions as "a feature guidance information acquiring section", a GPS that functions as "a current position information acquiring section", and display device that functions "a guidance providing section" as recited in claim 7 of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakane et al (US 2003/0045997) in view of Endo et al (US 2004/0169653).

Regarding claim 7, Nakane discloses (Figs. 1 and 2) a navigation device, comprising:

a feature guidance information acquiring section (Fig. 2, interface 37 and communication device 38) that acquires a feature guidance information readable from a recording medium (data storage unit 33, 34 and 36) storing a feature guidance information readable by a computing section (controller 20) for providing guidance on a feature by the computing section (20) when a movable body (Fig. 1, vehicle 5) is moved to a predetermined guidance position (the destination) located ahead of the position of the feature in a moving direction of the movable body (5) toward the feature (Figs. 8 and 12) (the feature can be map marks such as schools, hospitals, post office, gas stations, and etc. Section 117).

Nakane further discloses (Fig. 4) wherein an area representing a map divided into a plurality of sub-areas being associated with unique mesh information (M11-M55) (Sections 113-117).

Nakane further discloses (Figs. 4-9) a plurality of records (Figs. 5-7) including a unique feature information (Fig. 5, map mark of facility) associated with the respective features (school, hospital, etc.) with a unique guidance position of the feature (Fig. 12A and 12B), the records being further associated with the unique mesh (Fig. 6) to represent the position of the feature or the guidance information, is stored as one data (data storage unit 36) (Sections 123-124).

Nakane further discloses (Fig. 2) a current position information acquiring section (GPS 18) that acquires a current position information for a current position of the movable body (vehicle 5) (Section 125); and

a guidance providing section (display unit 40) that provides guidance on a feature by based on the acquired feature guidance information and the acquired current position information (Sections 126-128).

The only difference between the disclosure of Nakane and the claimed invention is that the claim requires that for each sub-areas includes at most one of the feature position and the guidance position.

However, Endo discloses (Figs. 1, 2, 10A and 16A) a navigation device that employs a two-dimensional Map Mesh (101), which is divided into sub-areas (four quadrants), wherein each sub-areas includes at most one of the feature position (destination point) and the guidance position (current position) (Sections 121-122).

Therefore, since Endo also mentions that "the display positions of any two points are selectively set to the central lower and upper sides of the screen in accordance with an instruction of the display positions of the two points" (Section 122), it would have been obvious to a person of ordinary skill in the art to use the Map Mesh (101) for the map mesh display system of Nakane so that a user can selectively set any feature, points of interest (POI), places, or any destination at any position on the Map Mesh whichever provides more convenient for the user.

Regarding claim 8, note the rejection as set forth above with respect to claim 7.

Regarding claim 9, note the rejection as set forth above with respect to claim 7. Nakane further discloses (Fig. 7) the recording medium (data storage unit 33, 34, and 36) comprising:

a feature data area (map data) that stores a unique feature information associated with the feature (Section 96);
a guidance position data area (70 and 71); and
a mesh data area (72).

Endo discloses (Fig. 10A) each sub-area includes at most one of the feature position (destination point) and the guidance position (current position) in pairs (Sections 121-122).

Regarding claim 10, note the rejection as set forth above with respect to claim 9.

Nakane further discloses (Figs. 4 and 12) wherein the unique feature information (water area, mountains, or pond), the unique guidance position information (Fig. 12 show a guidance arrow), and the unique mesh information are recorded as the single feature guidance information. See also Endo (Fig. 1, map mesh 101, station feature 104, and guidance position information 105).

Regarding claims 12-15, Nakane discloses (Fig. 2) a guidance providing section (display unit 40) that provides guidance on a feature by based on the acquired feature guidance information and the acquired current position information (Sections 126-128 and 137).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Hayashi et al (6,144,318) disclose (Figs. 8B, 10 and 11) a navigation system provides road guidance by displaying information relating to roads on a structure shape map, together with landmark information, in such a manner that only information around the present position is highlighted.

-Hayashi et al (6,035,253) disclose (Figs. 8-10) a navigation device with a coordinate matching process (Column 10, line 63 to column 11, line 20).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUU MATTHEW whose telephone number is (571) 272-7663. The examiner can normally be reached on Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JACK KEITH can be reached on (571) 272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. Luu



MATTHEW LUU
PRIMARY EXAMINER